

REMARKS / ARGUMENTS

These remarks are made in response to the Office Action mailed February 2, 2005. This response is filed after the 3-month shortened statutory period, and as such, a retroactive extension of time is herein requested. The Examiner is authorized to charge the appropriate extension fee to Deposit Account 50-0951.

In paragraphs 3-4 of the Office Action, claims 1-18 and 22-27 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,349,132 to Wesemann, et al. (Wesemann).

In response to the Office Action, Applicants have amended claims 1, 6, 10, 15, 22, and 25. Specifically, claims 1, 6, 10, 15, 22, and 25 have been amended to clarify that the Visual Browser and the Voice Browser are each implemented as functionally independent software components, as supported by page 9, lines 2-15, by page 11, lines 18-25, between page 12, line 25 and page 13, line 24, by page 3, lines 7-10, and throughout the specification.

Claims 1 and 10 have also been amended to clarify that the step of concurrently presenting results in a multimodal presentation, the multimodal presentation having a visual modality and an audible modality, functions for the visual modality being provided by the Visual Browser and functions for the audible modality being provided by the Voice Browser. These amendment is supported by page 9, lines 2-15, by original claim 19, by page 3, lines 7-10, by page 4, lines 11-22, by page 13, lines 5-24, and throughout the specification.

Claims 6, 15, 22, and 25 have also been amended to clarify that the concurrent presentation of audio and video content occurs in a coordinated and complementary fashion such that functions of visual browsing provided by the Visual Browser are synchronized with functions of voice browsing provided by the Voice Browser. Further, the Visual Browser can lack functions for providing voice browsing capabilities and the Voice Browser can lack functions for providing visual browsing functions. These

amendments are supported by page 9, lines 2-15, by page 1, lines 24-26, page 9, lines 5-8, page 9, lines 17-24, by page 13, lines 5-24, and throughout the specification.

No new matter results from these claim amendments.

A. Wesemann Fails to Teach Claimed Limitations

Prior to turning to specific rejections, a brief review of the Applicants' claimed invention may be helpful. The Applicants have provided a solution for presenting audible content within a Voice Browser and visual content within a Visual Browser concurrently, in a coordinated and synchronized fashion, thereby resulting in a multi-modal presentation of Web content. The solution does not require the Visual Browser to be a hybrid browser that includes speech handling code. Instead, the Visual Browser can lack voice browsing capabilities and the Voice Browser can lack visual browsing capabilities. This solution is a highly flexible one that is permits a user to utilize a user preferred Visual Browser in conjunction with a user preferred Voice Browser. Coordination and synchronization needed for the invention occurs through the use of references or markup tags embedded within retrieved network-based documents.

Turning to the cited art, Wesemann teaches using a content source that is able to be presented within a visual or voice browser without content transcoding or otherwise changing the content source. Wesemann accomplishes this by parsing content of an electronic document into various hieratical categories (claim 1) having hieratical links, where an audio representation can be communicated to a client based upon these links. Wesemann shows (FIG. 3) that a common HTML source 310 can be used by either a visual browser 302 or a voice browser 340.

Wesemann fails to contemplate the synchronization of an independent visual browser with an independent voice browser to concurrently present audio (via Voice Browser) and visual (via Visual Browser) content from a common source in a coordinated and complementary fashion, thereby resulting in a multi-modal presentation

of content (a visual portion presented in a Visual Browser and an audible portion presented within a Voice Browser).

Turning to the independent claims, Applicants claim:

- * identifying a Visual Browser and a Voice Browser, each implemented as functionally independent software components;

- * concurrently presenting visual content in the Visual Browser and audible content in the Voice Browser in a synchronized/ coordinated fashion (or as a single multimodal presentation).

These claimed limitations are not explicitly, inherently, or implicitly taught by Weseman. For the coordinated and concurrent presentation of content within a Visual Browser and Voice Browser, column 2, lines 20-37 and column 6, lines 18-36 are relied upon.)

Column 2, lines 20-37 discusses VoxML and its shortcomings. Specifically, that VoxML requires explicitly voice tags and that its use would require all existing content to be re-coded for these tags and that VoxML does not provide a common source to be used by both Voice and Visual browsers, which is taught by Wesemann. No mention of concurrent presentation of visual and audible content (as claimed by the Applicants) is present in this cited section.

Column 6, lines 18-36 includes a sentence that "Alternatively, Voice Browser 340 could be used in conjunction with Visual Browser 320 to provide simultaneous visual and audio interfaces."

Applicants assume (base upon FIG 3 and the specification of Weseman) that Wesemann is indicating that multiple applications (one being a Voice Browser 340 and another a Visual Browser 320) can be simultaneously instantiated within a multi-tasking operating environment (like windows) and executed within such an environment upon a single machine at the same time. That is (from FIG. 3), both visual browser 320 and voice browser 340 could be presented upon monitor 330 or telephone 350. In such an

embodiment, although a visual and audio interface could be simultaneously provided upon a single machine, each operating independently and autonomously from the other.

Wesemann does not teach or suggest that the content is to be presented in the visual browser and the content presented in the voice browser are to be concurrently presented in a coordinated, synchronized, and/or multi-modal fashion. Wesemann's teachings of establishing a hierarchical index lacks teachings and mechanisms necessary for integrating or synchronizing the visual and audio interfaces of a Voice Browser and Visual Browser together.

Wesemann does not teach coordination markup tags, which could be used to synchronize a Voice Browser and a Visual Browser. Instead, (column 8, lines 24-36) Wesemann teaches that category attributes (presumably used when parsing markup into a hierarchy index in accordance with the teachings of Weseman) can be used to map page content. These category attributes as used by Wesemann would not provide a means to synchronize and coordinate audio/visual content between the Visual Brower and Voice Browser as claimed by the Applicants.

Because Wesemann fails to explicitly or inherently teach each claimed limitation, the 35 U.S.C. § 102(e) rejections to claims 1-18 and 22-27 should be withdrawn, which action is respectfully requested.

B. The Applicants invention predates Weseman

The Patent Office continues to refuse to accept Applicants' Declarations and supporting Affidavit under 37 C.F.R. § 1.131 submitted to show that the Applicants' date of invention predates Wesemann. This represents the third time the 37 C.F.R. § 1.131 Declarations have been refused without the Applicants receiving relevant guidance consistent with the MPEP as how their proof under 37 C.F.R. § 1.131 was insufficient and without the Applicants being made aware of what information is necessary to satisfy the Examiner. Consequently, Applicants have prepared a more comprehensive response

regarding the § 1.131 Declarations to establish a record in anticipation of an Appeal or a Petition of MPEP 1002.02.

Applicants herein re-file the Declarations and supporting Affidavit under 37 C.F.R. § 1.131 showing the Applicants' date of invention predates Wesemann. The Declarations and Supporting Affidavit are accompanied by a copy of the Applicants' confidential invention disclosure (Disclosure) numbered BOC8-1999-0113 entitled "Method and Apparatus for Synchronized Voice and Visual User Interface Access to Internet Web-Based Information". The confidential invention disclosure, Declarations and Supporting Affidavit demonstrated proof of conception for the claimed subject matter of the Applicants' invention at least as early as November 11, 1999, which predates the December 16, 1999 filing date of Wesemann.

1. Conception

The Examiner stated in paragraph 6, that an insufficient showing of Conception had been provided and that "A party must show how an exhibit is mapped to the claims of the Application." Applicants are not aware of such a requirement under the MPEP for Conception, nor do the cited cases **when read in full in context of the decision** impose such a requirement.

MPEP section 715.02 details how much of the claimed invention must be shown to prove conception. This section states that an affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus) in the sense that the claim as a whole reads onto it. Further, where the differences between the claimed invention and the disclosure of the references are so small as to render the claims obvious over the reference, then the Affidavit or Declaration should be permitted.

This section further teaches that a 37 CFR § 1.131 declaration is not insufficient merely because it does not show the identical disclosure of the reference(s) or the

identical subject matter involved in the activity being relied upon. If the declaration contains facts showing a completion of the invention commensurate with the extent of the invention as claimed, the declaration or affidavit is sufficient, whether or not it is a showing of the identical disclosure of the reference or identical subject matter involved in the activity.

Further, even if Applicants' 37 CFR § 1.131 Declarations are not fully commensurate with the rejected claim, the Applicants can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR § 1.131 would have been obvious to one of ordinary skill in the art. Such evidence is sufficient because Applicants' possession of what is shown carries with it possession of variations and adaptations, which would have been obvious, at the same time, to one of ordinary skill in the art.

All the above being true, Conception of the Applicants' claimed invention is evidenced by the Disclosure. To satisfy the Examiner, the Applicants have mapped the limitations in claim 1 to the disclosure point by point in hopes of overcoming the objection to Conception without going through a petition or Appeal.

1. A method for concurrently accessing network-based electronic content in a Voice Browser and a Visual Browser comprising the steps of:

identifying a Visual Browser and a Voice Browser, which are each implemented as functionally independent software components; *(page 1 to page 2 – "whereby the visual and voice browsing can be synchronized without writing a new, separate hybrid browser, and without having to write new function directly into existing voice or visual browsers" AND page 2 "to make cooperating applications without reprogramming of either of the applications")*

retrieving a network-based document formatted for display in the Visual Browser; *(the essence is to have co-target type tags that are designed for the other browser in the*

cobrowsing pair. Using the Highway Example of page 2, combined with the co-target tags, "When the user asks to be shown say San Luis Obispo, the co-target in the voice markup tells the visual browser to visit the appropriate URL").

identifying in the retrieved document a reference to the Voice Browser, said reference specifying electronic content formatted for audible presentation in the Voice Browser; *(the co-target type tags are equivalent to the reference, the content formatted for audible presentation is the content referenced by the voice component to visit a URL associated with the Voice Browser)*

transmitting said reference to the Voice Browser; *(the co-target type tags are equivalent to the reference, the content formatted for audible presentation is the content referenced by the voice component to visit a URL associated with the Voice Browser)*

the Voice Browser retrieving said specified electronic content and audibly presenting said electronic content in the Voice Browser; *(the Voice Browser retrieves the audible content from a URL referenced by the co-target)*

the Visual Browser visually presenting said network-based document concurrently with said audible presentation, wherein the step of concurrently presenting results in a multi-modal presentation of the retrieved network-based document, the multi-modal presentation having a visual modality and an audible modality, functions for the visual modality being provided by the Visual Browser and functions for the audible modality being provided by the Voice Browser. *(from the end of page 1 of the Disclosure "The problem is how to create a multimodal aspect whereby the visual and voice browsing can be synchronized without writing a new, separate hybrid browser, and without having to write new function directly into existing voice or visual browsers. AND from page 2 of the Disclosure "It solves the problem using existing tags, in existing markup languages ... to make cooperating applications (actually it can be viewed as one*

application since they are now cooperating) without reprogramming of either of the applications, making it cost effective and practical.

Applicants note that each other claimed limitation can be similarly mapped to support within the Disclosure, as is evident to one of ordinary skill in the art. Applicants also emphasize that the Disclosure is a completion of an International Business Machines Corporation (IBM) confidential disclosure form, which is a standardized document utilized by the IBM and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the Disclosure once the Disclosure has been completed. Any changes and/or additions are appended as an attachment to the IBM confidential disclosure form together with the date the attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since November 11, 1999.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art. The present application, including each claim within the present application, has been prepared based upon the Disclosure. No additional information was relied upon other than the Disclosure and the Patent Attorneys' general knowledge of patent drafting and technical knowledge possessed by one of ordinary skill in the art in transforming the Disclosure into the present application.

Further, as noted in the enclosed Declarations, prior to submission of the application to the USPTO, the inventors reviewed the application to insure that the claims and material contained therein are fully supported by the Disclosure. The inventors performed such a review and swore to the same for the present application.

Applicants believe that they have provided a proper showing for Conception as required in accordance of the rules of the MPEP. Applicants respectfully request that the

Examiner point to specific limitations and claims that are believed to be insufficiently supported by the Disclosure in that these claimed limitations would not be obvious to one of ordinary skill in the art in light of the Disclosure. Applicants also request that the Examiner explicitly state those independent and dependent claims that the Examiner believes have proper support for Conception (assuming that the Examiner believes at least one claim is deficient and that at least one claim is not deficient). Applicants note that assuming proper Conception is shown for claims as well as Diligence, then at least as to those claims, the § 1.131 Declarations are valid, and the claims should be in an allowable state (in absence of other, heretofore un-cited references). Hence, if a portion of the claims have proper Conception and Diligence (according to the Examiner) and a different portion of claims lack Conception or Diligence, then the first portion (having Conception and Diligence) will be in an allowable state at least in regard to the reference in question and the Examiner is required indicate the allowability of those claims.

b. Diligence

Applicants further exercised due diligence from prior to the effective date of Wesemann until June 28, 2000, the filing date of the instant application. In regard to diligence, as set forth in the Declarations, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application, instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the application sufficiently details the inventive concepts detailed in the disclosure, at which time the application is expeditiously filed with the USPTO.

In paragraph 7 of the Office Action, the Examiner stated that an insufficient showing has been provided for the timeline prior to the effective date of Wesemann to the filing date of the present Application. The Examiner then proceeded to provide citations of cases, which taken together provide a distorted view of diligence. Applicants urge the Examiner to fully read a case before asserting an axiom from it as law, for otherwise the quotations are misleading and taken from context.

For example, the Examiner cited a case stating that "a 2-day period lacking activity has been held fatal – *In re Mulder*". Applicants note that case was one based upon the effect of EXPRESSED abandonment upon diligence with a later attempt to revive the case. This has nothing to do with the instant application, and in absence to facts showing expressed abandonment is irrelevant and potentially misleading.

In another example, the Examiner cites that "mere general statements are not enough to prove diligence". Applicants agree with this oft cited and even more often misused statement, generally. Applicants note, however, that the MPEP 715.07 sets forth the facts and documentary evidence of the facts are required for a 37 CFR § 1.131 Declaration. These facts can include supporting statements by witnesses MPEP 715.07(G) about verbal disclosures. Consequently, the sworn and notarized documents by the inventors and the in-house counsel (previously submitted) attesting to the facts as to diligence and conception are to be given factual weight. MPEP 715.07(H) states that disclosure documents (previously filed) may be used as documentary evidence of conception. Consequently, proof in accordance with MPEP 715.07 is not "a mere general statement" as the cited passage leads an unwary reader to believe.

Applicants shall not attempt to wade through the remainder of the case law citations provided by the Examiner, which are probably generally quoted to every Applicant when § 1.131 Declarations are being refused, regardless of whether the cited law is applicable or not. Applicants instead refer the Examiner to the MPEP, for a definition of diligence consistent with currently valid case law placed within relatively

reasonable contextual circumstances. The MPEP is, of course, the definitive manual that the Applicants and the Examiner are supposed to follow in matters relating to patent prosecution.

MPEP 715.07(a) states that an inventor is either diligent at a given time or he is not diligent, there are no degrees of diligence. Further, an applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. The record must set forth an explanation or excuse for the inactivity (such as time processing and preparing a patent application).

As to the period between December 16, 1999 (effective date of Wesemann) to June 28, 2000 (Filing date of the Application), this was a time period in which outside counsel spent drafting the present application, which according to MPEP 715.07(a) falls into a permissible explanation category, which provides a legally sufficient diligence during this period.

The practice of Akerman Senterfitt (outside counsel) is to prepare applications on a "First In, First Out" queue basis, with special priority being granted to cases having bar dates. This is a common practice in the industry for firms that prepare large volumes of patents for large corporate clients and is believed to be a reasonable practice within the meaning of MPEP 715.07(a).

As to proof of activity regarding the present application during the requisite time period, Applicants refer the Examiner to the following documents:

- Letter from IBM granting approval to prepare the patent application dated November 29, 1999
- Letter from Akerman to IBM acknowledging that the patent application would be prepared dated December 6, 1999 – note this letter establishes a target preparation date of May 29, 2000 (which is subject to change based upon queued workload as mentioned above in accordance with standard industry practices)

- Redacted docketing notes of March 29, 2000 showing the present application was in process
- Redacted docketing notes of April 29, 2000 showing the present application was in process
- Redacted docketing notes of May 29, 2000 showing the present application was in process
- Redacted docketing notes of June 6, 2000 showing the present application was filed June 28, 2000.

Since Applicants conceived of the present invention before the effective date of Wesemann and exercised due diligence in constructively reducing the invention to practice between the date of the Disclosure until the filing date, as supported by the enclosed Declarations, Wesemann should be withdrawn as a reference for purposes of 35 U.S.C. § 102. Consequently, the rejections to claims 1-18 and 22-27 under 35 U.S.C. § 102(e) based upon Wesemann should be withdrawn, which action is respectfully requested.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this response, or if the Examiner believes a telephone interview (**direct line 954.759-8937**) would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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